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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,392

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Jeffrey A. Blansit

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07/11/2007

LAW OFFICES OF CHRISTOPHER L. MAKAY

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EXAMINER

PERRIN, JOSEPH L

ART UNIT

PAPER NUMBER

1746

MAIL DATE

DELIVERY MODE

07/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/762,392

Applicant(s)

BLANSIT ET AL.

Examiner

Joseph L. Perrin, Ph.D.

Art Unit

1746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

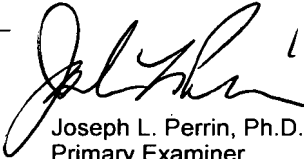
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-24.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


Joseph L. Perrin, Ph.D.
Primary Examiner
Art Unit: 1746

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive.

1. Regarding the §103 rejection over POINDEXTER, applicant argues that they "are unaware of any principle of patent law that allows its invention to be combined with a prior art reference." This is confusing since the rejection does not rely on combining with applicant's invention but rather on the well settled case law indicating that rearrangement of parts is well within the knowledge and skill generally available to one having ordinary skill in the art, the well established principal of functional equivalency, and the implicit teachings which are common knowledge in the art. Absent secondary considerations such as unexpected results, such rearrangement is not considered a patentable modification. It appears applicant is attempting to argue improper hindsight reasoning. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
2. Regarding applicant's argument that the proposed modification would change the principle of operation, citing *In re Ratti* and pointing to MPEP 2143.01(VI). However, *Ratti* is directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. Thus, the suggested combination of references would require a substantial reconstruction (i.e. rigidity vs. resiliency) and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate. Contrary to applicant's assertion, the simple rearrangement of the rejection would not result in a substantial reconstruction and the apparatus of POINDEXTER would function equally well. Accordingly, the *Ratti* case law and the instant rejection are not considered to be relatively comparable.
3. Further regarding POINDEXTER, applicant argues that rearranging the nozzles to a lower portion would not allow the apparatus of POINDEXTER to sanitize the entire collection path and would result in bacteria forming in unsanitized areas. This is considered speculative arguments and provides no factual showing of such results. That is, unlike *Ratti*, there is no factual showing of changing of operation in the prior art rejection as purported by applicant. Such simple rearrangement would still result in the sanitation of the collection path and clearly does not destroy or substantially alter the function of POINDEXTER. The Examiner, being well versed in the level of ordinary skill in the art, takes the position the spray nozzles could be sufficiently arranged to spray the entire collection path (i.e. widely sprayed and/or sprayed upwardly from a lower position) and sufficiently sanitize such path and that such configuration would be well within the level and skill generally available to one having ordinary skill in the art given the fact that various types of nozzle configurations, which are common knowledge in the art, could also be used and would easily function in this manner.
4. Similarly, applicant points to MPEP 2143.01 (V) and argues that "the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose". However, such arguments are considered speculative and are not persuasive for at least reasons of record. The rearrangement is well within the level of ordinary skill in the art and absolutely would not destroy the apparatus of POINDEXTER.
5. The Examiner notes that the cited references disclose each and every structural limitation of claimed invention, either explicitly, implicitly or inherently, and applicant's arguments are primarily directed to motivation for combining the well known structures as claimed and does not take into account the level of ordinary skill in the art. An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 82 USPQ2d 1687 (Fed. Cir. 2007); see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).
6. Regarding the combinations of POINDEXTER and LINDNER, applicant again points to MPEP 2143.01(VI) and argues that the principal operation is being modified. This is not persuasive for at least reasons already indicated previously. Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Since the combination would teach or reasonably suggest each and every structural limitation and/or functional limitation to one having ordinary skill in the art, the combination is deemed proper and the rejection is maintained.
7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
8. Regarding applicant's intended use arguments for POINDEXTER and LINDNER applicant argues that the intended use of the claimed invention is not taught by the combination. However, it is fundamental that an apparatus claim defines the structure of the invention and not how the structure is used in a process, or what materials the structure houses in carrying out the process. *Ex parte Masham*, 2 USPQ2d 1647, 1648 (BPAI 1987). See also *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705,706 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 1032, 168 USPQ 530, 534 (CCPA 1971); *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235,238 (CCPA 1967). As long as the apparatus of POINDEXTER and LINDNER is capable of providing tray cleaning, the prior art apparatus meet the requirements of the claimed feature. Applicant has not established on this record any structural distinction between apparatus within the scope of the rejected claims and the apparatus fairly described by the combination of POINDEXTER and LINDNER, and no such structural distinction is apparent. Additionally, applicant's argument that their disclosure is the only recitation of "drip tray" is completely without merit as both POINDEXTER and LINDNER disclose trays. It appears applicant heavily relies on the intended use of their apparatus as opposed to the claimed structural limitations which properly defines apparatus claims (see, for instance 35 USC §101). Such reliance on intended use is inconsistent with the well establish court findings. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469,

15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Accordingly, until such time the claimed apparatus is defined by structural limitation to patentably distinguish over the prior art, the combination of POINDEXTER and LINDNER reads on applicant's claimed apparatus.

9. Applicant's arguments are generally directed to motivation to combine and allegations that the Examiner has not provided prima facie rejections without clearly pointing out how the claimed invention is patentably novel. Accordingly, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how amendments avoid such references or objections.